

### **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to the Drawings because Figure 24 should be designated by the legend "Prior Art" because only that which is old is illustrated therein. In response, Figure 24 has been amended as suggested by the Examiner to include the legend "Prior Art." Accordingly, it is respectfully requested that the objection to the drawings be withdrawn.

In the Official Action, the Examiner objects to the Title of the invention because it is not descriptive. In response, the Title has been amended to --ELECTRONIC ENDOSCOPE APPARATUS AND SIGNAL PROCESSING APPARATUS HAVING DETACHABLE OPTION SUBSTRATE--. Accordingly, it is respectfully requested that the objection to the Title be withdrawn.

In the Official Action, the Examiner objects to the specification because (a) the heading "Disclosure of Invention" should be --Brief Summary of the Invention--, (b) because the Disclosure of the Invention section is merely a recitation of the claims, and (c) the section heading "Cross Reference of Related Applications" should appear as the first section in the disclosure.

With regard to (a) above, although such headings are merely suggested in 37 C.F.R. § 1.77(b) (specification "should include" such headings) and preferred as set forth in MPEP 608.01(a) (headings are "preferable"), in order to advance prosecution, the heading "Disclosure of Invention" has been changed to --Brief Summary of the Invention-- as suggested by the Examiner.

With regard to (b) above, the Applicant knows of no authority why the Summary of the Invention cannot paraphrase the claims. In fact, such a practice is preferred in current U.S. practice. Furthermore, both 37 C.F.R. § 1.73 and MPEP 608.01(d) indicate that the Summary of the Invention section should be **commensurate and consistent with the invention as claimed**. Therefore, the Applicant respectfully submits that the Summary of the Invention section of the present application already complies with 37 C.F.R. § 1.73 and MPEP 608.01(d) and that no amendment thereof is necessary.

With regard to (c) above, although the order of the headings are merely suggested in 37 C.F.R. § 1.77(b) (specification "should include" such headings in order) and preferred as set forth in MPEP 608.01(a) (order of headings is "preferable"), in order to advance prosecution, the specification has been amended to move the section heading "Cross Reference of Related Applications" and corresponding paragraph to the first section in the disclosure as suggested by the Examiner.

In view of the above, the Examiner is respectfully requested to withdraw the objection to the specification.

In the Official Action, the Examiner objects to claims 9 and 10 and 16 and 17 under 37 C.F.R. § 1.75 as being substantial duplicates. The Applicant respectfully disagrees. MPEP 608.03(k) confirms that Applicants can restate the invention in a reasonable number of ways and that only claims having a slight difference in wording can be rejected. Claims 9 and 16 differ substantially from claims 10 and 16, at least in that the second signal processor is not positively recited in claims 9 and 16. Therefore, claims 9 and 16 differ from claims 10 and 17 to a level in which it is permitted as a restatement of the invention.

Accordingly, the Examiner is respectfully requested to withdraw the objection to claims 9 and 10 and 16 and 17 under 37 C.F.R. § 1.75

In the Official Action, the Examiner rejects claims 9-24 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,690,410 to Mochida et al., (hereinafter “Mochida”).

In response, the Applicant respectfully traverse the Examiner’s rejection under 35 U.S.C. § 102(e) for at least the reasons set forth below.

The Applicant respectfully submits that the present invention as recited in independent claims 9-11, 16-18, 23 and 24 patentably distinguish over Mochida.

For example, independent claim 10 recites a first signal processor with a first output format and a second signal processor with a second signal format. Referring to Figure 13 of the present application, by way of example, the output format can be an NTSC output format for the first signal processor and an output format can be an HDTV output format (i.e., high resolution output format) for the second signal processor. Thus, the output formats can be different in the way they are displayed on a monitor.

Mochida discloses an image processing apparatus for an endoscopic image having a main substrate and an expansion substrate detachably coupled thereto, such that the expansion substrate can be added to the main substrate.

Figure 78 of Mochida discloses that the expansion substrate (1507) is connected to a main substrate (7) and that an expansion substrate (1508) is further connected to an expansion substrate (1507). The output for displaying based on the output of the CCD2 is output to the monitor (MONITOR) from the main substrate (7), a DV digital compression signal (DV OUTPUT) produced based on the output of the CCD2 is output to a DV recorder (not shown) from the expansion substrate (1507), and an MPEG2 digital compression signal (MPEG2

OUTPUT) produced based on a DV digital compression signal (DV OUTPUT) from the expansion substrate (1507) is output to an MPEG2 recorder (not shown) from the expansion substrate (1508).

Therefore, the Applicant respectfully submits that the output of the signal processor of the main substrate in Mochida is an output format for displaying on a monitor and the output of the signal processor of the expansion substrate is **not an output format for displaying** on a monitor but an output format for recording.

Thus, Mochida does not disclose or suggest a first signal processor that implements **a signal process of the image signal and outputs the processed image signal with a first output format** and a second signal processor **implementing the signal process of the image signal and outputting the processed image signal with a second output format** as recited in independent claim 10. The remaining independent claims have similar features.

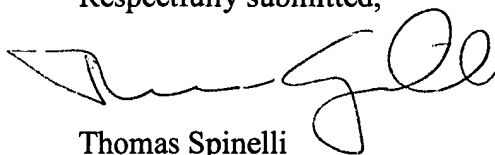
Thus, with regard to the rejection of claims 9-24 under 35 U.S.C. § 102(e), an electronic endoscope and signaling apparatus having the features discussed above and as recited in independent claims 9-11, 16-18, 23 and 24, is nowhere disclosed in Mochida. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>1</sup> independent claims 9-11, 16-18, 23 and 24 are not anticipated by Mochida. Accordingly, independent claims 9-11, 16-18, 23 and 24 patentably distinguish over Mochida and are allowable. Claims 12-15 and 19-22 being dependent upon claims 11 and 18, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 9-24 under 35 U.S.C. § 102(e).

---

<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', with a stylized flourish at the end.

Thomas Spinelli  
Registration No. 39,533

Scully, Scott, Murphy & Presser  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
516-742-4343  
TS/cm/dg

Enclosure (Amended Figure 24)